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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,750	07/15/2003	James Michael Mullins	P02716	8979

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EXAMINER

PICKETT, JOHN G

ART UNIT PAPER NUMBER

3728

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/620,750

Applicant(s)

MULLINS ET AL.

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 21-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 21-24 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Applicant's election with traverse of Group I, claims 1-20 in the reply filed on 12 May 2006 is acknowledged. The traversal is on the ground(s) that the examination of the additional inventions would not place a serious burden on the examiner and would place an undue burden on the applicant. This is not found persuasive because the fields of search are significantly divergent (as evidenced by their differing classifications) and would require the acquisition of a significant degree of cross-class knowledge. This represents a serious burden on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

Claims 21-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

### ***Specification***

2. The abstract of the disclosure is objected to because it is not directed to the elected invention. Correction is required. See MPEP § 608.01(b).

3. The disclosure is objected to because of the following minor informalities:

The brief description of Figures 7 and 8 both describe a "second step" yet detail differing processes.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1: As best determined by the examiner, the “capture means” and “passage means” are both directed to the felt material. Where a claim directed to a device can be read to include the same element twice, the claim may be indefinite. *Ex parte Kristensen*, 10 USPQ2d 1701 (Bd. Pat. App. & Inter. 1989).

Claims 2-10 and 12-20 are dependent on claim 1 and are rejected for the above reasons.

In claims 3 and 13, it is unclear as to whether the user’s hand is positively claimed. As a user’s hand represents non-statutory subject matter in an article claim, the examiner presumes the hand is not part of the claimed structures.

Further regarding claims 3 and 4: As best determined by the examiner, the “installation means”, “removal means”, and “protective means” are all directed to the glove. Where a claim directed to a device can be read to include the same element twice, the claim may be indefinite. *Ex parte Kristensen*, 10 USPQ2d 1701 (Bd. Pat. App. & Inter. 1989).

Further regarding claims 13 and 14: As best determined by the examiner, the installer, remover, and protector are all directed to the glove. Where a claim directed to

a device can be read to include the same element twice, the claim may be indefinite. *Ex parte Kristensen*, 10 USPQ2d 1701 (Bd. Pat. App. & Inter. 1989).

Claims 4-8 and 14-18 are dependent on claims 3 or 13 and are rejected for the above reasons.

Claims 10 and 20: A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, 2<sup>nd</sup> paragraph. *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990). Claims 10 and 20 are directed to both a packaged kit, and the process step of selling the kit.

Claim 11: As best determined by the examiner, the capturer and passer are both directed to the felt material. Where a claim directed to a device can be read to include the same element twice, the claim may be indefinite. *Ex parte Kristensen*, 10 USPQ2d 1701 (Bd. Pat. App. & Inter. 1989).

Claim 12 recites the limitation "said at least one capturer" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim. The examiner presumes the claim to be dependent on claim 11.

Claims 17 and 18 recite the limitation "said at least one package" in lines 1-2. There is insufficient antecedent basis for this limitation in the claims. The examiner presumes the claims to be dependent on claim 16.

Claim 19 recites the limitation "said at least one cover" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim. The examiner presumes the claim to be dependent on claim 11.

Claim 20 recites the limitations "said at least one cover" in line 2; "said at least one protector" in line 2; and "said at least one instruction" in line 3. There is insufficient antecedent basis for these limitations in the claim. The examiner is unable to make an appropriate assumption for dependency.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 10 and 20 are rejected under 35 U.S.C. 101 because they are directed to neither a machine nor a process, but rather embrace or overlap two different statutory classes of invention, whereas the statute is drafted so as to set forth the statutory classes in the alternative only. See MPEP 2173.05(p)(II).

### ***Means-Plus-Function Interpretations***

6. Claims 1-9 appear to invoke the provisions of 35 USC 112, 6<sup>th</sup> paragraph, the chart below indicates the examiners best determination of the structures claimed:

<b>Claim</b>	<b>Limitation</b>	<b>Definition</b>
1	Cover means	Cover 103; see page 12, lines 16-21.
	Capture means	Felt material; see page 12, lines 16-21 and page 13, lines 19-21.

	Passage means	Felt material; see page 12, lines 16-21 and page 13, lines 19-21.
2	Neutralization means	"Big Boss Cleaner/Degreaser"; see page 13, lines 8-11.
3	Installation means	Glove 104; page 17, line 23 to page 18, line 11.
	Removal means	Glove 104; see page 18, lines 12-17.
4	Protective means	Glove 104; see page 13, line 24 to page 14, line 1.
5	Instructive means	Instructions 101; see page 12, lines 4-8.
6	Package means	Bag 102; see page 12, lines 8-12.
7	Reusable Closure means	Closure portion of Bag 102: page 12, lines 8-12.
8	1 <sup>st</sup> Indicator means	Indicia 105; see page 12, lines 13-16.
9	2 <sup>nd</sup> Indicator means	Indicia 106; see page 12, lines 21-23.

Applicant has the right to challenge the interpretation of the means-plus-function limitations presented above, provided such challenge is accompanied by direct citation of the appropriate passages of the specification to which the means-plus-function limitations refer. Failure to include such citations will be considered non-responsive.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 2, 11, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Noland (US 5,270,136).

Claim 1: Noland discloses a protection system with a cover means **2**. Although disclosed as placed under a battery, mat **2** is fully capable of being placed on top of a battery. A recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). As best determined by the examiner, the claimed capture means and passage means is the felt material. Noland is made from a polypropylene felt material (as is applicant's cover means) and therefore inherently comprises a capture means and passage means based upon its material properties.

Claims 2 and 12: Noland discloses neutralization means (see for example, Col. 4, lines 50-63) that is the functional equivalent of the applicant's claimed neutralizer.

Claim 11: Noland discloses a protection system with at least one cover **2**. Although disclosed as placed under a battery, mat **2** is fully capable of being placed on top of a battery. A recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art



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apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). As best determined by the examiner, the claimed capturer and passer is the felt material. Noland is made from a polypropylene felt material (as is applicant's cover means) and therefore inherently comprises a capturer and passer based upon its material properties.

8. Claims 1, 9, 11, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Demott et al (US 6,774,067 B2; hereinafter Demott).

Demott discloses a cover/cover means **2**, a capturer/capture means **6**, a passer/passage means **4**, and a second indicator/indicator means (printed mater, see Col. 4, lines 57-58). Although disclosed as a mat, Demott is fully capable of being used as claimed. A recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 3, 4, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noland (US 5,270,136), as applied to claim 1 above, and further in view of Derda et al (US 4,718,125; hereinafter Derda).

As best determined by the examiner, the installer/installation means, remover/removal means, and protector/protective means all refer to the glove. Further, the claims as presented do not require any sort of proximity between the glove and the cover, and therefore amount to the claiming of the mere existence of the two structures.

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Derda discloses a glove (Figure 1) that is fully capable of being used in the claimed manner. Insofar as it is obvious for two structures to exist at the same time, claims 3, 4, 13, and 14 do not distinguish over Noland and Derda.

10. Claims 5-8 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noland-Derda as applied to claim 4 above, and further in view of Martin et al (US 6,140,796; hereinafter Martin).

As best determined by the examiner, the instruction/instructive means refers to a sheet of instructions, a package/package means refers to a bag, a re-usable closure/closure means refers to a bag seal, and a first indicator/indicator means refers to the indicia on the bag. Further, the claims as presented do not require any sort of proximity between the cover or the glove and the instructions or package, and therefore amount to the claiming of the mere existence of the structures. Martin discloses an instruction/instructive means 5, a package/package means 60, a re-usable closure/closure means 62, and a first indicator/indicator means (bag indicia, see Figure 3). Insofar as it is obvious for the structures to exist at the same time, claims 5-8 and 15-18 do not distinguish over Noland, Derda, and Martin.

#### ***Allowable Subject Matter***

11. Claims 10 and 20 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1<sup>st</sup> and 2<sup>nd</sup> paragraphs, and 35 U.S.C. 101, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

12. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

### ***Conclusion***


13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. McMorris and Martin et al (US 2,564,810) disclose felt corrosion protectors located over battery terminals. Williams, Jr. et al discloses a kit in a bag with instructions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Greg Pickett  
Examiner  
21 July 2006